

III. REMARKS

1. Claims 1, 2, 4-8, 12 and 13 are not unpatentable over Burke in view of Schmidt under 35 U.S.C. §103(a).

The Examiner is incorrect that Burke discloses "establishing the second call between the first network and the mobile station via the second network". Col. 1, lines 64-66 and Col. 11, lines 41-64 merely discuss the general process of switching an established call from one cell to another cell within the same network. There is simply no discussion in Burke of establishing a second call between the first network and the mobile station via a second network. This point was discussed in detail in the prior response and nothing has been presented that refutes that argument. Burke simply does not disclose or suggest a second call via a second network.

The Examiner should not generalize "communication networks" as described and claimed by Applicant, as "communication entities." This is improper and the Examiner should rely on Applicant's description and the specific claim language. The references need to disclose a "second call" via a "second network". However, they do not.

Col. 1, lines 64-66 merely speaks of the handoff process within the network, or "switching the established call from one cell...to another." There is no second call or second network described here. Rather, it is merely the "handoff" of a call from one cell to another.

Col. 11, lines 41-64, again speaks nothing of a second call or second network. Rather, again it is a discussion related to the "mobile being handed off" (line 54). Quite specifically, this

section speaks of connecting a call entirely "within the same system" (line 59). This section makes absolutely no mention of a second call or a second network as is described and claimed by Applicant.

Thus, for these and the reasons set forth in Applicant's prior response, Burke is, and remains, deficient when it comes to disclose the features of Applicant's invention.

Schmidt does not overcome the above noted deficiencies of Burke and as a result the combination of Burke and Schmidt cannot disclose or suggest each and every feature of Applicant's invention as required for a *prima facie* case of obviousness under 35 U.S.C. §103(a).

First, there is no motivation to combine Schmidt with Burke.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142).

There is no suggestion or motivation to modify or combine the references as proposed by the Examiner. Applicant's invention, as recited in the claims includes establishing a second call between a first network and a mobile station via a second network.

Burke measures a number of signal strengths from possible cells to which the mobile station may be handed over. The strongest

signal is selected and thus the most appropriate cell from the mobile to be handed over to is determined. There is no second call or second network in Burke.

In Schmidt, referring to FIG. 3, the system assumes that a particular base station (BTS 21-24) should be handed over to. Schmidt, referring to Col. 1, line 55 to Col. 2, line 3 discloses that a communication needs to be transferred from one transcoder of a MSC to another transcoder of another MSC. The concept is to effectuate the transfer without disrupting service to a mobile telephone as well as to avoid the need to link the transceivers. Again, no discussion of a second call via a second network as is claimed by Applicant. Thus, the Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Burke and Schmidt.

The references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation to combine Burke and Schmidt to establish a second call between a first network and a mobile station via a second network appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Burke and Schmidt under 35 U.S.C. §103(a) is not established.

Even if a skilled person were to combine the teachings of Schmidt with those of Burke, they would not arrive at the present invention. This is because Schmidt does not cure the deficiencies of Burke. Specifically, Schmidt does not disclose the establishment of a second call between a first network and a mobile station via a second network, nor does it disclose the transferring of data communication between the mobile station and the first network from the first call to the second call. Burke only discloses a conventional soft handover system in which communication is between mobile unit 80 and base transceiver station 21 at the start of the method and is transferred so that communication is between the mobile unit 80 and the base transceiver station 23, as the mobile unit has moved its location. This method of transfer is described in Col. 3, line 52 to Col. 6, line 13. In this description, there is no disclosure of the mobile unit 80 being in a first call, or of establishment of a second call. Instead, as can be understood from Col. 4, lines 52-62, the method merely concerns itself with allocating an appropriate radio channel which could be used for communication. This is not the same as the method of claim 1 which is concerned with establishment of actual calls.

Thus, the combination of Burke and Schmidt cannot result in the establishment of a second call between the first network and the mobile phone via a second network as claimed by Applicant.

Since there is no motivation to combine the references and the combination does not disclose or suggest each and every claim limitation of Applicant's invention, a *prima facie* case of obviousness under 35 U.S.C. §103(a) is not, and cannot be, established.

Furthermore, Applicant respectfully notes that Burke and Schmidt have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case Burke and Schmidt are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Neither Burke nor Schmidt are in the same field as the Applicants' invention.

Burke measures signal strengths to decide which cell to hand a call over to. Schmidt deals with transferring a communication from one transponder of a MSC to a transponder of another MSC. Neither Burke nor Schmidt deal with the handover of a mobile station communicating with a first network to communication via a second network. Burke and Schmidt deal solely with different cells within a single network. Thus, Burke and Schmidt are not analogous art and cannot be used for purposes of 35 U.S.C. §103(a).

2. Claim 3 is not unpatentable over Burke in view of Schmidt and further in view of Kumaki at least in view of its dependency on claim 1.

3. Claim 9 is not unpatentable over Burke in view of Schmidt and further in view of Gillig at least by reason of its dependency on claim 1.



Claims 10 and 11 are not unpatentable over Burke in view of Schmidt and further in view of Korpela at least by reason of their dependency on claim 1.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

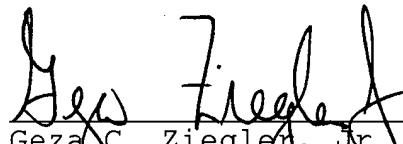
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Respectfully submitted,

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Technology Center 2000


Geza C. Ziegler, Jr.
Reg. No. 44,004

30 MARCH 2004
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800 Ext. 134
Customer No.: 2512

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